

### **STATUS OF THE CLAIMS**

Claims 10-13, 23, 32, 35, 37, 41, and 51-88 were previously canceled.

Claims 18, 33, 39, 46, 48 and 50 are presently canceled.

Claim 1-9, 14-17, 19-22, 24-31, 34, 36, 38, 40, 42-45, 47, 49 and 89-91 are pending.

Claims 1-9, 14-22, 24-31, 33, 34, 36, 38-40, 42-50 and 89-91 stand rejected.

Claims 1, 25, 29, 34, 36, 38, 42-45, 47, 49, 89 and 91 have been amended. No new matter is added.

Reconsideration of the present Application is respectfully requested.

### **REMARKS**

Applicant acknowledges with appreciation that the Examiner has entered Applicant's proposed amendments in Applicant's June 26, 2007 Amendment and Response to Final Office Action. *See, Advisory Action Before the Filing of an Appeal Brief*, at 1.

Applicant notes that Claims 1-2, 9, 14-21, 24-27, 29-31, 33-34, 36, 38-40, 42-50, and 90 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Goetz et al. (U.S. Patent No. 6,421,650, "Goetz") in view of Lion (U.S. Patent No. 6,330,491, "Lion"). Claims 3-8, 22, and 28 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion and further in view of Edelson et al. (U.S. Patent No. 5,737,539, "Edelson"). Claims 89 and 91 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Simcox et al. (U.S. Patent No. 5,992,890, "Simcox"). Applicant traverses these rejections for at least the following reasons.

### **35 U.S.C. § 103(a) Rejections**

Claims 1-2, 9, 14-21, 24-27, 29-31, 33-34, 36, 38-40, 42-50, and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion. Claims 3-8, 22, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion and further in view of Edelson. Claims 89, 13, and 91 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Simcox.

35 U.S.C. § 103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish obviousness, the scope and content of the prior art must first be determined. Second, the differences between the prior art and the claims at issue must be ascertained. Third, the level of ordinary skill in the relevant art must be determined. Finally, taking this background into consideration, the obviousness of the subject matter is determined. Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., can be utilized to determine the circumstances surrounding the origin of the subject matter sought to be patented. *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), M.P.E.P. § 2141.

**a) Goetz and Lion**

Claims 1-2, 9, 14-21, 24-27, 29-31, 33-34, 36, 38-40, 42-50, and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion. Without conceding to the Examiner's assertions, Applicant has amended independent claims 1, 25, 38, 45, 47 and 49 to include the limitation of receiving a reason for overriding a drug use alert. Accordingly, the erroneous rejections of claims 20 and 36 are the central issue since the reason for overriding a drug use alert of these claims has been incorporated in the remaining independent claims.

1) Claims 20 and 36

Claims 20 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion. Applicant respectfully disagrees for at least the following reasons.

Independent Claim 20 discloses "entering via the electronic prescription creation device a reason for overriding the drug use evaluation alert." Claim 36 discloses "a plurality of representations each corresponding to a motive for overriding a drug use evaluation alert." The Office Action posits that Goetz teaches these elements (*see, Office Action of January 26, 2007, at 4, referring to Office Action of May 4, 2006, at 8 and 12*), in that Goetz discloses "a specific caution note would preferably be generated and downloaded to the patient component...describing the interaction." Goetz, col. 16, lines 45-47 (emphasis added). While Goetz teaches generating a "caution note" **to the patient**, such caution note generation is not equivalent to a reason for overriding the drug use evaluation alert (i.e., as disclosed in Applicant's Claim 20), nor to representations corresponding to a motive for overriding a drug use evaluation alert (i.e., as disclosed on Applicant's Claim 36). A caution note may warn a **patient** of a problem and, as Goetz discloses, describe an interaction, but a warning or

description of an interaction is not a reason or motive for overriding an alert. Reasons and motives for overriding an alert, such as are disclosed in Applicant's Claims 20 and 36, are a physician's reasons for ignoring an alert, and the pharmacist's concern with regard to whether the prescription should be filled. As such and as noted above, a caution note and a reason are not one in the same, and thus, it is clear that the teachings of Goetz fail to disclose this element of Applicant's invention. *See, generally*, Goetz. Nowhere in Goetz is a reason or motive for overriding an alert taught.

This deficiency of Goetz is not remedied by the addition of Lion, nor does the Office Action suggest that it is. Lion fails to teach the element of documenting a reason for overriding a drug use evaluation alert, as well as fails to teach the element of a plurality of representations each corresponding to a motive for overriding a drug use evaluation alert. *See, generally*, Lion. Because Goetz and Lion fail to disclose this feature of Claims 20 and 36, not all of the elements of Claims 20 and 36 are taught. No matter how the cited references are combined, this feature of the claimed invention cannot be found. Thus, Goetz and Lion cannot render independent Claims 20 and 36 obvious.

Accordingly, Applicant submits independent Claims 20 and 36 of Applicant's invention are allowable.

2) Claims 1, 25, 38, 45, 47, and 49

Applicant has amended independent claims 1, 25, 38, 45, 47 and 49 to include the limitations of documenting a reason for overriding a drug use interaction alert such as by receiving it at an electronic prescription creation device. No new matter has been added. Amended independent claims 1, 25, 38, 45, 47, and 49 require entry or receipt of a reason for overriding the drug use evaluation alert. As discussed above, neither Goetz nor Lion teach this

limitation. Goetz merely discloses a “caution note” for a patient (i.e., “may cause drowsiness”) which is not a reason for overriding a drug use evaluation alert, and not a plurality of representations each corresponding to a motive for overriding a drug use evaluation alert (i.e., “do not prescribe to pregnant women”). Therefore, Applicant submits that the rejection under 35 U.S.C. §103 should be withdrawn with respect to claims 1, 25, 38, 45, 47, and 49.

Because Goetz and Lion fail to disclose all the elements of independent Claims 20 and 36, and amended independent Claims 1, 25, 38, 45, 47, and 49, Goetz and Lion cannot render independent Claims 1, 20, 25, 36, 38, 45, 47, and 49 obvious.

Accordingly, Applicant submits at least independent Claims 1, 20, 25, 36, 38, 45, 47, and 49 of Applicant’s invention are allowable. Applicant further submits that each of the dependent claims (Claims 2, 9, 14-19, 21, 24, 26-27, 29-31, 33-34, 39, 40, 42-44, 46, 48, 50, and 90) are similarly distinguishable over the prior art of record, at least by virtue of each Claim’s ultimate dependency from the patently distinct base Claims 1, 20, 25, 36, 38, 45, 47, and 49.

**b) Goetz, Lion, and Edelson**

Claims 3-8, 22, and 28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion and further in view of Edelson. Applicant respectfully disagrees for at least the following reasons.

**1) Claim 22**

Claim 22 has also been rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Lion and further in view of Edelson. Applicant respectfully disagrees for at least the following reasons.

Independent Claim 20, from which Claim 22 depends, discloses “entering...a reason for overriding the drug use evaluation alert.” As discussed above, neither Goetz nor Lion discloses this element of Applicant’s invention. The deficiencies in the disclosures of Goetz and Lion are not remedied by the addition of Edelson, nor does the present Office Action suggest that they are. Edelson discloses ways that a system may alert a user to potential problems with prescribing medication. *See, generally*, Edelson. Despite these teachings, Edelson fails to disclose the element of a reason for overriding a drug use evaluation. *See, generally*, Edelson. Nowhere in Edelson is this element taught. Because Edelson fails to disclose this feature of Claim 20, not all of the elements of Claim 20 are taught. No matter how the cited references are combined, this feature of the claimed invention cannot be found. Thus, Goetz, Lion, and Edelson do not render independent Claim 20 obvious.

Accordingly, Applicant submits at least independent Claim 20 of Applicant’s invention is allowable. Applicant further submits that dependent Claim 22 is similarly distinguishable over the prior art of record, at least by virtue its ultimate dependency from the patently distinct base Claim 20.

## 2) Claims 3-8, and 28

Claims 3-8 depend from independent Claim 1. Claim 28 depends from independent Claim 25. Both independent Claims 1 and 25 have been amended to include a reason for overriding the drug use evaluation alert. As discussed above, neither Goetz nor Lion disclose this element of Applicant’s invention. As further discussed above, the deficiencies in the disclosures of Goetz and Lion are not remedied by the addition of Edelson, nor does the Office Action suggest that they are. Nowhere in Edelson is this element taught. Because Edelson fails to disclose this feature of amended Claims 1 and 25, not all of the elements of Claims 1 and 25

are taught. No matter how the cited references are combined, this feature of the claimed invention cannot be found. Thus, Goetz, Lion, and Edelson do not render independent Claims 1 and 25 obvious.

Accordingly, Applicant submits at least independent Claims 1 and 25 of Applicant's invention are allowable. Applicant further submits that each of the dependent claims (Claims 3-8 and 28) are similarly distinguishable over the prior art of record, at least by virtue of each Claim's ultimate dependency from the patently distinct base Claims 1 and 25

**c) Goetz and Simcox**

Claims 89 and 91 have been rejected under 35 U.S.C. § 103 as being unpatentable over Goetz in view of Simcox. Applicant traverses this rejection for at least the following reasons.

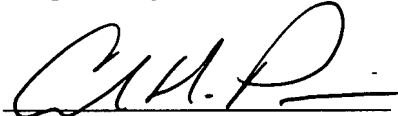
Claims 89 and 91 have been amended to include a reason for overriding a drug use evaluation alert. As discussed above, Goetz fails to disclose this feature of the claimed invention. The deficiency in the disclosure of Goetz is not remedied by the addition of Simcox. Simcox discloses a prescription media that provides a plurality of visual indicia to give a positive correlation between the prescribed pharmaceutical and the pharmaceutical's application. See Simcox, col. 2, lines 5-10. Nowhere in Simcox is there disclosed an override of a drug use evaluation alert, let alone a reason for overriding the drug use evaluation alert. Thus Goetz and Simcox do not render independent Claims 89 and 91 obvious.

Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) with respect to claims 89 and 91 be withdrawn.

## CONCLUSION

Applicant respectfully submits that this application now meets the requirements for the issuance of a Notice of Allowance and Applicant respectfully requests the same at the earliest possible time.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'C.H. Pierce', written over a horizontal line.

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